RESPONSE AND REMARKS

ELECTION/RESTRICTION

The Office Action withdrew Claims 22-26, 39-59, 77-99 and 115-137, asserting that those Claims are directed to an invention that is independent or distinct from the invention originally claimed and elected in response to a previous restriction requirement. *Office Action*, Topic Nos. 2-3, pgs. 2-3. The Listing of Claims above reflects the withdrawal of Claims 22-26, 39-59, 77-99 and 115-137.

CLAIM REJECTIONS UNDER SECTION 103(a)

In the Office Action, Claims 1-10, 19-21, 60-65 and 100-102 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schwab et al. (U.S. Patent Application Publication No. U.S. 2002/0019777; "*Schwab*") in view of Siegel (U.S. Patent Application Publication No. U.S. 2004/0143519; "*Siegel*"). *Office Action*, Topic Nos. 4-8, pgs. 3-5.

Claims 10-12, 27, 62-65, 103, and 138-141 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Schwab* and *Siegel* and further in view of Kara (U.S. Patent No. 6,233,568; "*Kara*"). *Office Action*, Topic Nos. 9-11, pgs. 5-6.

Claims 13-21, 27, and 65 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Schwab*, *Siegel*, and *Kara* as applied to Claim 11 above, and further in view of UPS® Service Guide (www.ups.com) ("*UPS*"), FedEx® Services (www.fedex.com) ("*FedEx*") and Barnett et al. (U.S. Patent No. 6,369,840; "*Barnett*"). *Office Action*, Topic Nos. 12-15, pgs. 6-7.

RESPONSE REMARKS REGARDING CLAIM REJECTIONS UNDER SECTION 103(a)

The rejections of the Claims have been carefully considered. Claims 1, 62-63, 138-139, and 141 have been amended to more distinctly claim the claimed invention.

An Online Retail System's Display of Returnable Items Comprising Shipped Items Purchased Through the Online Retail System is Patentably Distinct From the References of Record

It is respectfully submitted that _Schwab_ discloses a system by which a "third party establishment (agent) acts as an agent to an e-commerce or catalog merchant (merchant) ... [for] process[ing] product returns for that merchant." _Schwab_, Abstract. It is respectfully submitted that _Schwab_ discloses a merchant sending a document, referred to in _Schwab_ as a "ReturnCERT 501", with a product ordered by a consumer when the product is shipped to the consumer. _Schwab_, Paragraph 0051.

In _Schwab_, "[s]hould the consumer 20 then wish to return the product 503, he can present the ReturnCERT 501 to a local third party 60." _Schwab_, Paragraph 0052. In _Schwab_, after a consumer had presented a ReturnCERT to a third party agent for a merchant from which the consumer had purchased the item to be returned, "[t]he third party 60 would then scan, using scanner 601 or in some other fashion interpret the ReturnCERT 501, as may be suitable or known to those skilled in the art, and link or enter the ReturnCERT 501 data into his computer system 603." _Schwab_, Paragraph 0052.

As compared to a consumer having to present a document to a local return agent as disclosed in _Schwab_, Claim 1 of the present application, for example, is directed to an online merchandise return computer system programmed to:

> receive through an online retail computer system of a particular online merchant, an indication of a shipment of an at least one item of merchandise purchased by the consumer through the online retail computer system;
> in response to the indication of shipment, designate <u>through the online retail computer system,</u> the at least one item as a returnable item;
> receive through the online retail computer system a request by the consumer for an identification of returnable items;
> in response to the request, generate a display through the online retail computer system to the consumer of the identification of returnable items, wherein the identification of returnable items comprises an identification of the at least one item of merchandise ...

It is respectfully asserted that the above-cited recitation by Claim 1 is patentably distinguished from the above-cited disclosure of _Schwab_ of a consumer presenting a document to a local agent for the agent's entry into a system.

It is respectfully asserted that the disclosure of _Schwab_ of a consumer presenting a document to a local agent for the agent's entry into a system would not provide a consumer with the ability to input a merchandise return request into the same online retail computer system from which the consumer purchased the item to be returned. Therefore, it is respectfully submitted that various embodiments of the limitations of Claim 1 would be useful over _Schwab_ in that various embodiments of the limitations of Claim 1 would allow a consumer to input a merchandise return request into the same online retail computer system from which the consumer purchased the item to be returned.

Further, it is respectfully asserted that neither _Schwab_, nor any of the other references of record, disclose, anticipate, teach or suggest, in view of the above-recited limitations of Claim 1, the recitation of Claim 1 of the further limitation "...wherein the merchandise return request comprises a designation of a particular respective interactive means associated with a particular respective item of merchandise identified in the purchase identification...." _See also, e.g._, the recitation by Claim 138 of "...wherein the merchandise return request comprises an indication of an item on the list of items...."

Claimed Limitations Regarding a Display Through an Online Merchant's Retail Computer System of an Identification of Returnable Items Comprising Shipped Items that were Purchased by a Consumer Through the Online Merchant's Retail Computer System are Patentably Distinct From the References of Record

Even in view of the above-recited limitations of Claim 1, the Office Action asserts that even though _Schwab_ "... fails to disclose the use of a display, which displays each item of a previous order and an interactive means associated with each item in each order, to return an item ...", the Office Action asserts that "Siegel discloses a return

system where a user's previous orders along with each item in the order are displayed, and each item is associated with a checkbox, which the examiner considers to be an interactive means, to submit a return request ...." *Office Action*, Topic No. 6, p. 4 (citing Figure 1A of Siegel and the "corresponding detailed description").

The Office Action asserts that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schwab to include the display and interactive means of Siegel, in order to provide a single action return process to reduce the amount of sensitive information transmitted to increase security and ease of use for the customer ...." *Office Action*, Topic No. 6, pgs. 4-5 (citing *Siegel*, pgs. 1 and 2).

The portion of *Siegel* cited as support for the above-outlined assertion of obviousness states that "...since the client identifier identifies a user-preference profile preferably stored at the server system, there is no need for sensitive information to be transmitted via the Internet or other communication medium." *Siegel*, p.2, ¶ [0013]. It is respectfully asserted that the same paragraph of *Siegel* may be instructive as to types of sensitive information, stating that "[t]he server system then preferably completes the merchandise return by adding the user-specific return information for the user that is mapped to that client identifier to the item return information (e.g., product identifier, retailer, credit account, etc.).

However, as compared to *Siegel*, *Schwab* indicates that *Schwab*'s "ReturnCERT" contains such sensitive information as the consumer's credit card type and account number. *See, e.g.*, FIG. 11 of *Schwab*; *Schwab*, p. 6, ¶ [0064]. In *Schwab*, after a consumer presents a ReturnCERT to a third party service center, the ReturnCERT is scanned in, and "[i]f valid, the ReturnCERT data is transmitted to the merchant ...." *Schwab*, p. 6, ¶ [0065].

It is respectfully asserted that the disclosure of *Schwab* of the transmitting of ReturnCERT data that includes, among other things, sensitive information relating to the consumer's credit card account number, controverts the assertion of the Office Action that "[i]t would have been obvious ... to modify Schwab to include the display and interactive means of Siegel, in order to provide a single action return process to reduce

the amount of sensitive information transmitted to increase security and ease of use for the customer ...." *See Office Action*, Topic No. 6, pgs. 4-5

Further, it is respectfully asserted that the above-outlined assertions by the Office Action regarding motivation to modify the *Schwab* system to combine elements found in *Siegel*, amount to hindsight based on the teachings of the present invention. It is respectfully asserted, for the reasons given above, that rather than support the Office Action's assertion of obviousness, the references controvert the assertion of motivation to combine. It is respectfully asserted that, absent supporting evidence, picking and choosing disparate portions of the various references and then combining and modifying those disparate portions to conclude obviousness of various limitations of the rejected Claims and/or the Claims as amended constitute hindsight using the invention claimed in the present application as a roadmap. It is respectfully submitted that such hindsight is forbidden in the analysis of obviousness. *See, e.g., In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995) (Opinion by Judge Easterbrook; "... decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis. ... (Citations omitted) ... With hindsight the transistor is obvious; but devising the transistor was still a work of genius. An invention lies in a combination of elements that are themselves mundane. 'Virtually all inventions are combinations and virtually all are combinations of old elements.' ...(Citations omitted) ... Unless the prior art itself suggests the particular combination, it does not show that the actual invention was obvious or anticipated. ...(Citations omitted)."). In view of the above-cited prohibition against hindsight by *In re Mahurkar*, and for the reasons given above, it is respectfully asserted that the obvious-to-modify assertion by the Office Action is unsupported.

Moreover, for the reasons described below, it is respectfully asserted that the various linked portions of *Schwab* and *Siegel* still do not disclose the above-cited claimed limitations of independent Claim 1.

It is respectfully asserted that none of the references of record, whether considered alone or in combination, disclose, anticipate, teach or suggest the combination of limitations of independent Claim 1 for "...generat[ing in response to the request by the consumer for an identification of returnable items] a display through the online retail computer system to the consumer of the identification of returnable items, wherein the identification of returnable items comprises an identification of the at least one item of merchandise [purchased by the consumer through the online retail computer system and shipped]...",.

As distinguished from *Siegel*, Claim 1 claims designating an item that has been shipped, not merely purchased, as a returnable item. It is respectfully submitted that although *Siegel* mentions listing purchased items as returnable, *Siegel* does not describe any consideration of a shipment status of an item before listing an item for return. It is respectfully asserted that various embodiments of the limitations of Claim 1 would be useful over the *Siegel* system in that only shipped items would be listed as returnable, thereby preventing possibly confusing listing of items purchased but not yet shipped as returnable, as would be possible under *Siegel*.

As compared to an online store's displaying as returnable items, shipped items purchased by a consumer through that online store, *Siegel* describes a server system that creates a transaction listing of items a user has purchased from various retailers. *Siegel*, ¶0026. *Siegel* discloses a display of the purchases the user has made from the various retailers. *See, e.g., Siegel*, FIG. 1A.

As compared to a display to the consumer through the online merchant's retail computer system through which items were purchased, for the reasons given below, *Siegel* describes a system that combs numerous data bases in order to "gather" information to populate a transactions database. *See Siegel*, FIG. 2, element 215 ("Transaction Database"); *Siegel*, FIG. 5, element 535 ("Gather Transaction History for User"); *Siegel*, ¶0045. *Siegel* explains that the transactions are gathered from a collection of databases for multiple retailers and other sources. *Siegel*, ¶0045 ("... transactions database 215 can be maintained at another location as well as created real-time from a collection of databases located at member retail sites, credit card sites

or other data bases."); *see also, e.g., Siegel*, ¶0008 ("the method preferably includes identifying a user, gathering a transaction history associated with the identified user and displaying the transaction history associated with the identified user").

It is respectfully asserted, for the following reasons, that Claim 1 is patentably useful over *Siegel*.

It is respectfully submitted that, according to *Siegel*, in order for a user of *Siegel* to view the *Siegel* listing of a particular purchase, the user would need to have previously made the purchase through another website. *See, e.g., Siegel*, ¶0026 ("The server system adds transaction listing 101 and detailed item description 104 to each web page for the item(s) the user has purchased from various retailers."); *see also, e.g.,* FIG. 1A.

In order to return the purchased item, it is respectfully asserted that the *Siegel* user would subsequently need to log in to the *Siegel* website to view the *Siegel* listing of purchases made by the user from various retailers and to arrange for a return of the item. *See, e.g., Siegel*, ¶0008 ("the method preferably includes identifying a user, gathering a transaction history associated with the identified user and displaying the transaction history associated with the identified user").

As compared to *Siegel* in which a user would need to enter a website outside of the online retailer's website through which the item was purchased, the limitations of Claim 1 recite "... in response to the indication of shipment [of an at least one item of merchandise purchased ... through the online retail computer system], designate through the online retail computer system, the at least one item as a returnable item; ... in response to [a] request [for an identification of returnable items], generate a display through the online retail computer system to the consumer of the identification of returnable items...." It is respectfully asserted that rather than having to log on to a website external to an online retailer as disclosed in *Siegel*, a user of various embodiments of the limitations of Claim 1 would be able to view a listing of items purchased and shipped, and select one of the items for return processing (*see* Claim 1 reciting "... receive a merchandise return request ..."), using the same online website through which the purchases were made.

For the above-given reasons, because it is respectfully asserted that independent Claim 1 is patentably distinct from the references of record, it is respectfully asserted that the Claims that are dependent on Claim 1, namely, Claims 2-21, are therefore also patentably distinct from the references of record.

The Limitation "… Wherein the Return Policy Rules Comprise a Selection of Carriers and a Selection of Delivery Services with which a Consumer can Ship a Return Package …" is Patentably Distinct From the References of Record

The Office Action asserts that *Kara* in combination with *Schwab* and *Siegel* discloses the limitations of Claims 10-12. *Office Action*, Topic Nos. 9-11, pgs. 5-6.

The Office Action further asserts that "[i]t would have been obvious … to modify Schwab, to include the ability to select a carrier and calculate the shipping rates for the carriers according to Kara, in order … for the user to make an informed choice as to the most preferable method of shipment." *Office Action*, Topic No. 10, pgs. 5-6.

It is respectfully asserted that the obvious-to-modify assertion by the Office Action fails to consider every limitation of the rejected Claims 10-12.

Independent Claim 1 recites the limitation that "… a set of return policy rules [is] input to the online merchandise return computer system by the particular online merchant …." Claim 10 that depends on Claim 1, recites the additional limitation "… wherein the return policy rules comprise a selection of carriers and a selection of delivery services with which a consumer can ship a return package."

It is respectfully asserted that the above-recited combination of limitations, when all of the limitations are considered, is distinguished from the references of record. "… [W]hen evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, (United States Patent and Trademark Office; *Official Gazette* Notices for November 22, 2005), § II.C (*citing Diamond v. Diehr*, 450 U.S. 175,

188-89, 209 USPQ 1, 9 (1981) ("It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.")).

In view of the mandate by the *Interim Guidelines* to consider every limitation of a claim as a whole, it is respectfully asserted that none of *Schwab*, *Siegel*, *Kara*, nor any of the other reference of record, whether considered alone or in combination, disclose the combination of limitations of Claims 1 and 10 for "... a set of return policy rules [that is] input to the online merchandise return computer system by the particular online merchant ..." and "... wherein the return policy rules comprise a selection of carriers and a selection of delivery services with which a consumer can ship a return package."

It is respectfully asserted that there is no disclosure in *Schwab*, *Siegel*, *Kara*, or any of the other references of record, whether considered alone or in combination, of the above-recited combination of limitations of Claims 1 and 10 of a selection by a Merchant of carriers with which a consumer can ship a return item.

It is respectfully asserted that various embodiments of the above-recited combination of limitations of Claims 1 and 10 would be useful over the system described in *Siegel* and the other references of record, in that providing a Merchant with the ability to select carriers for shipping returns would allow the Merchant more control over return shipping quality and costs.

For the above-given reasons, because it is respectfully asserted that the combination of limitations of Claims 1 and 10 is patentably distinct from the references of record, it is respectfully asserted that the Claims that are dependent on Claim 10, namely, Claims 11-12, are therefore also patentably distinct from the references of record.

Yet further, similar to the reasons given above with respect to Claim 1, it is respectfully asserted that the limitations of Claims 62, 138 and 141, including the limitations for generating a display of carriers for shipping a returned item, are patentably distinct from the references of record. In particular, amended Claim 62 is

directed to a method using a computer for online merchandise return shipping comprising:

> collecting a set of return policy rules input by a merchant comprising an identification by the merchant of a set of carriers that may be used by a consumer for shipping an item of merchandise;
> saving said set of return policy rules in a database;
> receiving a merchandise return request by a consumer to return to a merchant a particular item of merchandise; and
> in response to the merchandise return request, generating a display to the consumer of the set of carriers identified by the merchant according to the return policy rules for use by the consumer for shipping the particular item of merchandise to the merchant.

It is respectfully asserted that there is no disclosure in _Schwab_, _Siegel_, _Kara_, or any of the other references of record, whether considered alone or in combination, of the above-recited limitations of Claim 62 of "... generating a display to the consumer of the set of carriers identified by the merchant according to the return policy rules for use by the consumer for shipping the particular item of merchandise to the merchant."

It is respectfully asserted that various embodiments of the above-recited limitations of Claim 62 would be useful over the system described in _Siegel_ and the other references of record, in that providing a Merchant with the ability to select carriers that may be used by a consumer for shipping an item of merchandise, would allow the Merchant more control over return shipping quality and costs.

Because for the above-given reasons, it is respectfully asserted that Claim 62 is patentably distinct from the references of record, it is respectfully asserted that the Claims that are dependent on Claim 62, namely, Claims 63 and 64, are therefore also patentably distinct from the references of record.

Further, for reasons similar to those given above with respect to Claims 1 and 62, it is respectfully asserted that the limitations of Claim 138 and 141, including the limitations for generating a display of carriers for shipping a returned item , are patentably distinct from the references of record.

In particular, amended Claim 138 is directed to a computer system for online merchandise return shipping comprising a computer device programmed with:

a set of instructions for collecting a set of return policy rules input by a merchant, wherein the return policy rules input by the merchant comprises a set of carriers selected by the merchant for use by consumers for shipping returned items;

a set of instructions for saving said set of return policy rules in a database;

a set of instructions for presenting to a consumer a list of items of merchandise previously purchased from the merchant and shipped by the merchant to the user;

a set of instructions for receiving a merchandise return request by the consumer to return an at least one item of merchandise;

a set of instructions for displaying to the consumer, in response to the merchandise return request, the set of carriers selected by the merchant for use by the consumer for shipping returned items;

a set of instructions for receiving an identification by the consumer of a carrier from the set of carriers, and a delivery service provided by the carrier, for return shipping of the at least one item of merchandise to a return location for the merchant; and

a set of instructions for printing a machine-readable carrier shipping label for delivery of the at least one item of merchandise to the return location for the merchant.

It is respectfully asserted that there is no disclosure in _Schwab_, _Siegel,_ _Kara_, or any of the other references of record, whether considered alone or in combination, of the above-recited limitations of Claim 138 of, for example, "… policy rules input by the merchant comprises a set of carriers selected by the merchant for use by consumers for shipping returned items …" and "…receiving an identification by the consumer of a carrier from the set of carriers…."

It is respectfully asserted that various embodiments of the above-recited limitations of Claim 138 would be useful over the system described in _Siegel_ and the other references of record, in that providing a Merchant with the ability to select carriers for shipping returns and requiring the selection of a carrier by the consumer to be from the set of carriers identified by the merchant, would allow the Merchant more control over return shipping quality and costs.

Because for the above-given reasons, it is respectfully asserted that Claim 138 is patentably distinct from the references of record, it is respectfully asserted that the Claims that are dependent on Claim 138, namely, Claims 139-140, are therefore also patentably distinct from the references of record.

Still further, similar to the reasons given above with respect to Claims 1, 62, and 138, it is respectfully asserted that none of *Schwab*, *Siegel*, or *Kara*, nor any of the other references of record, disclose, anticipate, teach or suggest the recitation of Claims 27 and 103 of the limitation "...wherein the set of carriers and the set of services are selected by the computer system for display according to a set of return policy rules input by the merchant ..."; or the recitation of Claim 141 of the limitation of "...wherein the set of carriers and the set of delivery services are selected according to a set of return policy rules previously input by the merchant ..."; or the recitation of Claim 65 of the limitation of "...said carriers and services selected by the computer system for display according to a set of return policy rules input by a merchant...".

Identifying at Least One Item as an Exception to Standard Return Policy Rules is Patentably Distinct From the References of Record

It is respectfully asserted that the limitations of independent Claim 100 are patentably distinct from the references of record. In particular, Claim 100 recites:

> generating a graphic user interface for input of return policy rules, wherein the graphic user interface is adapted for receiving input identifying an item as an exception to standard return policy rules;
> collecting a set of return policy rules input by a merchant using the graphic user interface, wherein the set of return policy rules comprises an identification of at least one item as a policy rule exception; and
> saving the set of return policy rules in a database.

It is respectfully asserted that the provision by various embodiments of the above-mentioned limitations of Claim 100 would be useful over the references of record in that the claimed exception definition and processing would provide a merchant with the ability to establish general return rules for broad categories of merchandise and designate certain items as exceptions to the general return rules.

Yet further, it is respectfully asserted that neither *Schwab*, nor any of the other references of record, disclose, anticipate, teach or suggest the recitation of Claim 100 of the limitation for "...generating a graphic user interface for input of return policy rules,

wherein the graphic user interface is adapted for receiving input identifying an item as an exception to standard return policy rules...".

For the above-given reasons, because it is respectfully asserted that amended independent Claim 100 is patentably distinct from the references of record, it is respectfully asserted that the Claims that are dependent on Claim 100, namely, Claims 101-102, are therefore also patentably distinct from the references of record.

Further still, it is respectfully asserted that neither *Schwab*, nor any of the other cited references, disclose, anticipate, teach or suggest the recitation by *e.g.*, Claims 60, 62, 65, of the limitation "... wherein a subset of the return policy rules input by the merchant comprises: a set of return questions; and a set of anticipated return question responses corresponding to each of said return questions...".
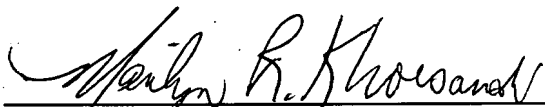
CONCLUSION

For the above-given reasons and for the authorities cited above, it is respectfully asserted that none of *Schwab*, *Siegel*, *Kara*, *UPS*, *FedEx*, *Barnett*, or any other reference of record, whether considered alone or in combination, disclose, anticipate, teach or suggest all of the limitations of the amended Claims.

Therefore, in view of the foregoing amendments, and for the foregoing reasons, it is respectfully asserted that the invention disclosed and claimed in the present application as amended is not fairly taught by any of the references of record, taken either alone or in combination and that the application is in condition for allowance. Accordingly, it is respectfully requested that the present application be reconsidered and allowed.

Respectfully submitted,

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